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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/516,968 | 12/03/2004 | Hideo Harada | 37251 | 3138 |
| 116 | 7590 | 09/23/2005 | EXAMINER | |
| PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108 | | | FOX, BRYAN J | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2686 | |

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/516,968

Applicant(s)

HARADA ET AL.

Examiner

Bryan J. Fox

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 6-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claims 6-8 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim may not be dependent upon another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 6-8 have not been further treated on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-5 and 9, the phrase "folder type" renders the claims indefinite because the addition of the word "type" to an otherwise definite expression (e.g., folder or mobile phone) extends the scope of the expression so as to render it indefinite (*Ex parte Copenhaver*, 109 USPQ 118 (Bd. App. 1955)). See MPEP § 2173.05(b).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 5 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Pawlish et al (US005276916A).

Regarding **claim 1**, Pawlish et al disclose a communication device that includes a first housing portion 11 and a second housing portion 12 hinged together with a speaker in the first housing portion and a microphone on the second housing portion (see column 2, lines 28-44 and figure 1), which reads on the claimed, "folder type mobile phone in which a first case having a transmission microphone and a second case having a receiver are coupled to each other so as to be opened and closed freely," and, "a speaker, which is provided at a portion of the second case which is exposed when the first case and the second case are closed." The system includes volume up and down controls, which reads on the claimed, "volume variable unit which adjusts a sounding volume of the speaker to a level substantially same as a sounding volume of the receiver." A position switch comprising sensing means to determine the relative position of the housing portions 11 and 12 and coupled to the controller in order to provide automatic control features in the radio 10 relating to the positions of the housing portions. When the radio is in the open position, the volume of the speaker port is set to a different level than in the open position (see column 2, line 65 – column 3, lines 42), which reads on the claimed, "switching unit which switches setting functions so that a first function for communicating by using the transmission microphone and the receiver is set in a case of communicating at a state that the first case and the second case are opened to each other, and a second function for communicating by using the transmission microphone and the speaker is set such that the sounding volume of the

receiver by the volume variable unit in a case of communicating at a state that the first case and the second case are closed to each other.”

Regarding **claim 4**, Pawlish et al disclose the use of a position switch used for determining the relative position of the housing portions 11 and 12 and coupled to the controller in order to provide automatic control features relating to the positions of the housing portions 11 and 12. When the radio is in the open position, a different configuration is used than when the phone is in a closed positions (see column 2, line 65 – column 3, line 42), which reads on the claimed, “the switching unit switches to the first function when the first case and the second case are opened to each other in a state that the second function is set.”

Regarding **claim 5**, Pawlish et al disclose the use of a position switch used for determining the relative position of the housing portions 11 and 12 and coupled to the controller in order to provide automatic control features relating to the positions of the housing portions 11 and 12. When the radio is in the open position, a different configuration is used than when the phone is in a closed positions (see column 2, line 65 – column 3, line 42), which reads on the claimed, “the switching unit switches to the second function when the first case and the second case are closed to each other in a state that the first function is set.”

Regarding **claim 9**, Pawlish et al disclose a communication device that includes a first housing portion 11 and a second housing portion 12 hinged together with a speaker in the first housing portion and a microphone on the second housing portion

(see column 2, lines 28-44 and figure 1), which reads on the claimed, "folder type mobile phone in which a first case and a second case are coupled to each other so as to be opened and closed freely," and, "a speaker, which is provided at a portion of the second case which is exposed when the first case and the second case are closed." The system includes volume up and down controls. A position switch comprising sensing means to determine the relative position of the housing portions 11 and 12 and coupled to the controller in order to provide automatic control features in the radio 10 relating to the positions of the housing portions. When the radio is in the open position, the volume of the speaker port is set to a different level than in the open position (see column 2, line 65 – column 3, lines 42), which reads on the claimed, "switching unit, which switches the speaker so that the speaker is available as a receiver at a time of communication; and an adjusting unit, which adjusts a sounding volume of the speaker to a lower level than a sounding volume at a time of an incoming call in a state of available to use the speaker as the receiver."

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pawlish in view of Imai (US006389267B1).

Regarding **claim 2**, Pawlish et al disclose a communication device that includes a first housing portion 11 and a second housing portion 12 hinged together with a speaker in the first housing portion and a microphone on the second housing portion (see column 2, lines 28-44 and figure 1), which reads on the claimed, "folder type mobile phone in which a first case having a transmission microphone and a second case having a receiver are coupled to each other so as to be opened and closed freely," and, "a speaker, which is provided at a portion of the second case which is exposed when the first case and the second case are closed." The system includes volume up and down controls, which reads on the claimed, "volume variable unit which adjusts a sounding volume of the speaker to a level substantially same as a sounding volume of the receiver." When the radio is in the open position, the volume of the speaker port is set to a different level than in the open position (see column 2, line 65 – column 3, lines 42), which reads on the claimed, "switching unit which switches setting functions so that a first function for communicating by using the transmission microphone and the receiver is set in a case of communicating at a state that the first case and the second case are opened to each other, and a second function for communicating by using the transmission microphone and the speaker is set such that the sounding volume of the

receiver by the volume variable unit in a case of communicating at a state that the first case and the second case are closed to each other." Pawlish et al fail to expressly disclose a first button which has a function of a first communication starting operation unit and a second button having a function of a second communication starting operation unit.

In a similar field of endeavor, Imai discloses a system where when a call arrives and the second key operation section 8 is operated, the first speech transmitting and receiving unit is set to be inactive and the second speech transmitting and receiving unit is set to an active state. On the other hand, when the first key operation section 5 is operated without operation of the second key operation section 8 in the step S103, the speech communication is started in the states just as it is (see column 6, lines 16-26), which reads on the claimed, "first button, which has a function of a first communication starting operation unit, and provided at a portion which is not exposed when the first case and the second case are closed but exposed in a opened state of the first case and the second case; a second button having a function of a second communication starting operation unit and provided at a portion which is exposed when the first case and the second case are closed."

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Pawlish et al with Imai to include the above buttons for choosing the communication section in order to allow the user to choose the communication state.

Regarding **claim 3**, Pawlish et al disclose a microphone port 24 exposed when the case is closed (see column 2, lines 40-44 and figure 2), which reads on the claimed, "the transmission microphone is provided at a portion of the first case which is away from a coupling portion of the first and second cases and exposed when the first case and the second case are closed." Pawlish et al fails to disclose a receiver covered by the first case when the first case and second case are closed.

In a similar field of endeavor, Imai discloses a system with a receiver that is covered when closed (see figures 2a and 2b), which reads on the claimed, "the receiver is provided at a portion of the second case which is away from the coupling portion and covered by the first case when the first case and the second case are closed."

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Pawlish et al with Imai to include the above receiver that is covered by the case when closed in order to protect the receiver and provide a more balanced device.

Regarding **claim 4**, the combination of Pawlish et al and Imai discloses the use of a position switch used for determining the relative position of the housing portions 11 and 12 and coupled to the controller in order to provide automatic control features relating to the positions of the housing portions 11 and 12. When the radio is in the open position, a different configuration is used than when the phone is in a closed positions (see Pawlish et al column 2, line 65 – column 3, line 42), which reads on the

claimed, "the switching unit switches to the first function when the first case and the second case are opened to each other in a state that the second function is set."

Regarding **claim 5**, the combination of Pawlish et al and Imai discloses the use of a position switch used for determining the relative position of the housing portions 11 and 12 and coupled to the controller in order to provide automatic control features relating to the positions of the housing portions 11 and 12. When the radio is in the open position, a different configuration is used than when the phone is in a closed positions (see Pawlish et al column 2, line 65 – column 3, line 42), which reads on the claimed, "the switching unit switches to the second function when the first case and the second case are closed to each other in a state that the first function is set."

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Toki (US006678504B1) discloses a foldable handy phone.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan J. Fox whose telephone number is (571) 272-7908. The examiner can normally be reached on Monday through Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2686

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marsha D Banks-Harold

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Bryan Fox
September 18, 2005